

08-21-00

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✓ #11

## CERTIFICATE OF MAILING

I certify that this REQUEST FOR RECONSIDERATION is being deposited with the U.S. Postal Service as Express Mail, Label No. EL426614965US, under 37 CFR 1.10 and is addressed to the Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

Dated: August 17, 2000

*Sobelman*  
Signature of Person Mailing Correspondence

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Inventor: Blandina et al. Docket No.: 10655.7117  
Serial No.: 09/241,188 Filing Date: February 1, 1999  
Group Art No.: 2761 Examiner: To Be Assigned

Title: STORED VALUE TRANSACTION SYSTEM  
HAVING AN INTEGRATED DATABASE  
SERVER

Adjustment date: 09/27/2000 LGIBBS  
08/24/2000 VVAN11 00000108 09241188  
01 FC:122 -130.00 OP  
Repln. Ref: 09/27/2000 LGIBBS 0012562600  
DAH:192814 Name/Number:09241188  
FC: 704 \$130.00 CR

## REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

Dear Commissioner:

Petitioner submits this Request for Reconsideration in response to the Petitions Examiner's "Decision Refusing Status Under 37 CFR 1.47(a)" mailed July 18, 2000. Petitioner filed a Petition to Accept the Oath/Declaration on behalf of the inventors who refused to sign in accordance with 37 CFR 1.47 on May 17, 1999 in response to the Missing Parts notification mailed on February 17, 1999. In response to the Petition, the Petitions Examiner cites to a letter dated January 28, 1999 (see attached Exhibit 1) from Mr. Pollack to Mr. Sobelman that states that Mr. Berry and Ms. Belczynski were provided with an incomplete application, and as such, the Examiner asserts that Petitioner did not satisfy the Petition requirements under 37 CFR 1.47(a) requiring that the inventors refused to join in the application. In response, Petitioner would like to clarify the references in the January 28, 1999 letter. Particularly, as noted in the re: line

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08/24/2000 VVAN11 00000108 09241188 130.00 OP  
01 FC:122

of the January 28, 1999 letter, the letter refers to the review of U.S. Patent Application Serial No. 09/105,406, which is a previously filed patent application of which the present application (Application Serial No. 09/241,188) claims priority. After Petitioner received the January 28, 1999 letter from the inventors' counsel, Petitioner subsequently filed present application no. 09/241,188 on February 1, 1999 with an unsigned declaration. As stated in the letter dated March 5, 1999 (see attached Exhibit 2) to inventor Michael Blandina, Petitioner requests Mr. Blandina's new signature on the declaration for the current application no. 09/241,188 and explains that "we were forced to file a new patent application claiming priority to the original patent application". The entire patent application including the specification, claims, drawings and a new declaration was attached as an enclosure to the letter to Michael Blandina dated March 5, 1999. Additionally, because inventors Robert Berry and Mari Belczynski were represented by counsel, Petitioner also sent a separate letter dated March 5, 1999 (see attached Exhibit 3) to their attorney, Mr. Bradley Pollock, which explains that we filed a new patent application and also includes a full patent application including the specification with claims, drawings and a new declaration.

The Petitions Examiner next asserts that an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The Petitions Examiner also states that no declaration executed by joint inventor Blandina accompanied the Petition. In response, Petitioner asserts that a declaration signed by Michael Blandina was submitted with the Response to Notice to File Missing Parts dated May 17, 1999 (see attached Exhibit 4) which was filed along with the Petition. However, for the Examiner's convenience, another copy of the executed declaration by joint inventor Blandina is attached to this Request. Petitioner also entered Mr. Berry and Ms. Belczynski's residence, citizenship and post office address into the declaration. For the Examiner's convenience, each inventor's residence, citizenship and post office address is set forth below:

Mari Belczynski  
6925 S. Riveria Way  
Aurora, CO 80016  
U.S. Citizen

Robert Berry  
6612 S. Royal Harvest Way, #31  
Salt Lake City, UT 84121  
U.S. Citizen

The foregoing addresses are each omitted inventors last known address.

The Petitions Examiner next asserts that a change of correspondence address has not been filed in this case and that the address given on the Petition differs from the address of record. Petitioner's attorney is:

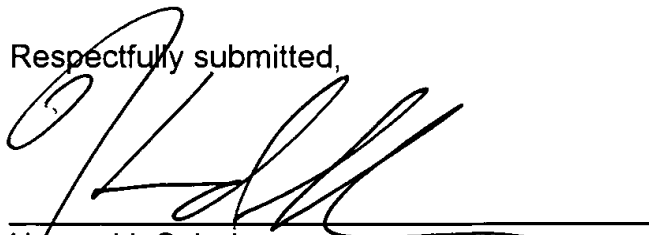
Snell & Wilmer L.L.P.  
One Arizona Center  
400 E. Van Buren  
Phoenix, AZ 85004-2202

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Attorneys Howard Sobelman and Brett Carlson are both attorneys associated with Snell & Wilmer law firm and both attorneys have been associated with Snell & Wilmer law firm before the initial filing date of the patent application. Accordingly, all correspondence should be directed to the Snell & Wilmer address set forth above.

A check in the amount of \$130.00 as required by 37 CFR § 1.17(h) is enclosed. The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR 1.16 or any patent application processing fees under 37 CFR 12.17 associated with this communication or credit any overpayment to Deposit Account No. **19-2814**. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

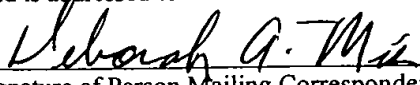
  
Howard I. Sobelman  
Reg. No. 39,038

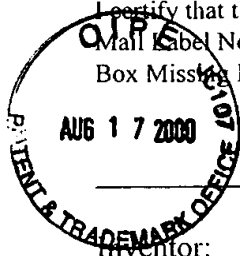
Dated: August 17, 2000

**SNELL & WILMER L.L.P.**  
One Arizona Center  
400 E. Van Buren  
Phoenix, AZ 85004-2202  
(602) 382-6228

CERTIFICATE OF MAILING

I certify that this document and fee is being deposited on **May 17, 1999** with the U.S. Postal Service as Express Mail Label No. EL214092210US under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Box Missing Parts, Washington, D.C. 20231.

  
Signature of Person Mailing Correspondence



Inventor: Blandina et al.

Docket No.: 10655.7117

Serial No.: 09/241,188

Filing Date: February 1, 1999

Group Art No.: 2761

Examiner: To Be Assigned

Title: STORED VALUE TRANSACTION SYSTEM  
HAVING AN INTEGRATED DATABASE  
SERVER

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**RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION  
FILING DATE GRANTED**

Assistant Commissioner for Patents  
Box Missing Parts  
Washington, D.C. 20231

Dear Sir/Madam:

This response to the Notice to File Missing Parts of Application - Filing Date Granted mailed on **February 17, 1999**.

Enclosed herewith for filing are the following:

A copy of the Notice to File Missing Parts of Application - Filing Date Granted.  
**(REQUIRED)**; and

Executed Declaration for Patent Application.

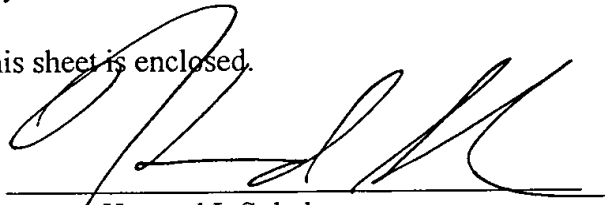
Completion of application fees as calculated below:

Surcharge for late payment of filing fee and/or late filing of original declaration or oath	\$130.00
Total completion of application fees	\$130.00
Total fees due	\$130.00

The fee of \$130.00 is to be paid as follows:

- X A check in the amount of the fee is enclosed.
- X The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **19-2814**  
A duplicate copy of this sheet is enclosed.
- X If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. **19-2814**  
A duplicate copy of this sheet is enclosed.

Dated: May 17, 1999

  
Howard I. Sobelman  
Reg. No. 39,038

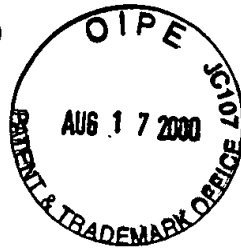
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**Snell & Wilmer**

L.L.P.  
LAW OFFICES

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Phoenix, Arizona 85004-0001  
(602) 382-6000  
Fax: (602) 382-6070



PHOENIX, ARIZONA

TUCSON, ARIZONA

IRVINE, CALIFORNIA

SALT LAKE CITY, UTAH

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OFFICE OF PETITIONS

Howard I. Sobelman (602) 382-6228  
Patents, Trademarks & Copyrights  
Internet: hsobelman@swlaw.com

March 5, 1999

**VIA FEDERAL EXPRESS**

Mr. Bradley P. Pollock  
Bell & Pollock  
26 W. Dry Creek Circle  
Littleton, CO 80120

**FedEx**

8021 1374 1062

FedEx Tracking Number — PULL UP PURPLE TAB

Re: Global Pilot Platform Patent Application  
Our File No. 10655.7100

Dear Mr. Pollock:

We reviewed your letter dated January 28, 1999. Snell & Wilmer Law Firm represents American Express with respect to its patent matters only. To the extent that your clients believe employment related issues may exist regarding the circumstances of their departure from American Express, such issues should be addressed with American Express. Irrespective of such possible issues, your clients' legal obligation to assist American Express in pursuing its patent protection for the Global Pilot Platform System remains because your clients' contribution to the development of the Global Pilot Platform System was within the scope of their duties as American Express employees.

With respect to the patent issues, due to your clients' lack of compliance with our previous requests, we were forced to take appropriate action to avoid abandonment of the patent application by filing a new patent application. Michael Blandina recognized his obligations and cooperated with American Express by simply reviewing the parent patent application and signing the appropriate declaration and assignment. As such, the new patent application incorporates the minor amendments suggested and approved by Mr. Blandina and claims priority on the first patent application under 35 U.S.C. §120. Similar to the previous application, we must now obtain your clients' signatures on the attached new declarations and assignments.

Although your clients asserted that they previously reviewed the first patent application in September, 1998, they now assert that they need substantial additional

Mr. Bradley P. Pollock  
March 5, 1999  
Page 2



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time to review the minimal changes to the application before deciding whether to execute the Declaration. Thus, to allow your clients ample time to review the patent application, we request that the enclosed documents be executed and returned to my office no later than **March 23, 1999**. Additionally, to assist in your clients' review of the new patent application, the following are the changes from the earlier filed application.

### IN THE SPECIFICATION

On page 4, line 6, after "various" insert --stored value product--.  
On page 4, line 8, change "shared" to --stored--.  
On page 5, line 16, change "an object" to --a functionality--.  
On page 6, line 10, change "applications" to --products--.  
On page 7, delete lines 8-16.  
On page 8, line 7, change "is" to --supports--.  
On page 8, line 7, change "sub-entities" to --customers--.  
On page 8, line 12, change "clients 138" to --franchisers 142--.  
On page 8, line 24, change "entity clients 138" to --entities--.  
On page 11, line 10, change "108 and 112" to --128 and 136--.  
On page 12, line 20, delete "shared" and substitute therefor --stored--.  
On page 12, line 24, delete "does" and substitute therefor --may--.  
On page 13, line 24, delete "In a preferred embodiment, balancing system 118 additionally".  
On page 14, delete lines 1-2.  
On page 14, line 4, change "clients 138" to --customers using stored value products--.  
On page 15, line 20, change "shared" to --stored--.  
On page 16, line 13, change "shared" to --stored--.  
On page 16, line 16, delete "graphical".  
On page 22, line 6, change "for example" to --such as--.  
On page 22, line 23, change "transaction" to --transactions--.

### IN THE CLAIMS

Claim 1, line 5, delete "is capable of".  
Claim 1, line 6, change "associating" to --associates--.  
Claim 1, line 9, delete "being capable of".  
Claim 10, line 5, delete "being".  
Claim 10, line 6, delete "capable of".  
Claim 10, line 8, delete "being capable of".

Mr. Bradley P. Pollock  
March 5, 1999  
Page 3



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American Express remains willing to honor its previous offer to pay each of your clients for up to four hours to review the new application, declaration, assignment and execute the declaration and assignment. As stated in my previous correspondence, American Express is willing to pay a reasonable hourly rate which your client's currently bill for their services at their new positions (*i.e.*, Robert Berry's consulting rate at Michael Blandina's company). Furthermore, it is understood that you and your clients will respect the confidentiality of the patent application.

We look forward to your prompt return of the executed declarations and assignments. In the meantime, if you or your clients have any questions related to the new application or the changes to the new application, we would be more than happy to discuss any aspect of the patent application with you or your clients.

We appreciate your forwarding the attached information to your clients and obtaining the appropriate signatures in a timely manner.

Sincerely,

SNELL & WILMER LLP

Howard I. Sobelman

HIS:dm

Enclosures

cc: Judith Rinearson  
Robert Miller  
Michael K. Kelly



# Snell & Wilmer

L.L.P.  
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TUCSON, ARIZONA

IRVINE, CALIFORNIA

SALT LAKE CITY, UTAH

Howard I. Sobelman (602) 382-6228

Patents, Trademarks & Copyrights  
Internet: hsobelman@swlaw.com

March 5, 1999

## VIA FEDERAL EXPRESS

Michael Blandina  
7596 S. Telluride Court  
Aurora, CO 80016

Re: Global Pilot Platform Patent Application  
Our Ref. No.: 10655.7117

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Dear Michael:

As you may know, Robert Berry and Mari Belczynski did not execute the required declaration within the appropriate time to avoid abandonment of the patent application. Thus, to avoid abandonment, we were forced to file a new patent application claiming priority to the original patent application.

As such, we must obtain your execution of the attached declaration and assignment. To assist in your review, the attached patent application is similar to the prior application, except the attached patent application includes the additional changes which you previously approved in the preliminary amendment from the prior application.

We would appreciate receiving the executed declaration and assignment in my office no later than March 23, 1999. In the meantime, if you have any questions related to the new application, declaration or assignment, we would be happy to discuss them with you.

Sincerely,

SNELL & WILMER L.L.P.

Howard I. Sobelman

HIS:dm

Enclosures

cc: Michael Kelly (w/o encls.)  
Robert Miller (w/o encls.)  
Judith Rinearson (w/o encls.)  
Analydia Shooks (w/o encls.)

**BELL & POLLOCK, P.C.****ATTORNEYS AT LAW**

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Suite 575  
Littleton, Colorado 80120  
Phone (303) 795-5900  
FAX (303) 730-7000

Steamboat Springs Office  
Mountain Office Park  
2955 Village Drive  
Main Floor  
Steamboat Springs, CO 80488  
(970) 870-8989  
1-800-559-5920

January 28, 1999

**VIA FACSMILIE 602-382-6070**

Howard I. Sobelman  
One Arizona Center  
Phoenix, AZ 85004-0001

Re: U.S. Patent Applications Serial Number:09/105, 406  
Titled: Stored Value Transaction System including an Integrated Database Server  
filed June 26, 1999

Dear Mr. Sobelman:

Thank you for your very threatening letter of January 27, 1999. Perhaps a brief history of the facts as I understand them will help to explain our position and possibly result in some type of cooperation from your offices rather than the threats which you have directed to this office and against my clients.

As I understand it, Mari Belczynski, Robert Berry and Michael Blandina are the inventors of a stored value transaction system including an integrated database server. It is not my understanding that Ms. Belczynski's and Mr. Berry's contributions to this technology were first conceived by them while they were full time employees of American Express nor was it my understanding that their participation in the development of this technology was directly related to the scope of their employment with American Express.

In an attempt to address this matter I did make contact with Ms. Rinearson on Tuesday, January 25, 1999 to obtain all documents with regard to this matter. I requested that Ms. Rinearson provide for me the employment contracts for my clients, any and all documentation identifying the scope of their employment while working for American Express, all documents concerning the compensation to them and describing the basis upon which the compensation was provided and all documents identifying all terms and conditions under which my clients employment with American Express ended. I expressed to Ms. Rinearson my concern that

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**OFFICE OF PETITIONS**

A. Gary Bell, Jr.  
Diplomate-National Board  
of Trial Advocacy

Bradley P. Pollock  
Chad P. Hemmat

Craig M. Berube \*  
Brian S. MacKenzie \*\*

\* Also admitted in  
New Mexico  
\*\* Also admitted in  
Michigan

Howard I. Sobelman

January 28, 1999

Page 2

American Express was in fact requesting something from my client to which it was not entitled. I had pointed out to Ms. Rinearson that Ms. Belczynski alone had lost approximately \$150,000 as a result of the actions taken by American Express when the employment relationship ended. It appears to me that the timing with regard to the actions taken by American Express against Ms. Belczynski and Mr. Berry was very calculated to insure that certain rights to which Ms. Belczynski and Mr. Berry would have been entitled in the near future would not be enjoyed by them. Mr. Berry lost substantial value as well as the result of the termination of his employment.

It is also my understanding that from the time that the employment of Ms. Belczynski and Mr. Berry ended until some time in early September no further contact was made to either Ms. Belczynski or Mr. Berry concerning this matter. However, in early September certain documents were provided to both Ms. Belczynski and Mr. Berry for what appeared to be the purpose of review and execution so as to benefit American Express. American Express took no actions to identify upon what basis it believed it could come to previous employees and require additional services from those employees for the benefit of American Express. Notwithstanding the same, Ms. Belczynski and Mr. Berry, after a very cursory review of the documents, wrote to American Express in early September of 1998 informing American Express that the system described in the subject was not the system that was invented either by Ms. Belczynski or Mr. Berry. Therefore, neither Ms. Belczynski nor Mr. Berry felt they could sign the subject application. **NO FURTHER CONTACT WAS MADE BY AMERICAN EXPRESS FROM EARLY SEPTEMBER UNTIL JANUARY 27, 1999 TO EITHER MS. BELCZYNSKI OR MR. BERRY.** No attempt were made by American Express to discuss the application with either Ms. Belczynski or Mr. Berry, to obtain their input, to determine the problems that they might have had with any documents provided or to discuss with either one of them the system that they had invented.

On or about January 22, 1999 Mr. Blandina and his assistant did provided certain documents to Ms. Belczynski and Mr. Berry. According to Ms. Rinearson, Mr. Blandina did not and does not represent American Express with regard to this matter, is not an employee or contractor of American Express with regard to this matter and does not speak on behalf of American Express concerning this matter. I have no knowledge or information which would indicate that Mr. Blandina acts as an agent on behalf of American Express with regard to this matter. If he does please provide the necessary documentation which would verify his position.

When documents were provided to my clients on January 22, 1999 they contacted me for a meeting. We met on January 25, 1999 at which time, while my clients were in the office, I attempted to call Ms. Rinearson. However, I was informed that Ms. Rinearson was not available and therefore I had to wait until January 26, 1999 to speak with Ms. Rinearson. During that conversation I expressed to her our concerns with regard to whatever legal duties or requirements my clients might have, the fact that my clients are very much interested in and will in fact fulfill any legal responsibilities, duties and obligations they have and that they expect American

Howard I. Sobelman  
January 28, 1999  
Page 3

Express to fulfill its legal duties and responsibilities including appropriately compensating my clients for the value of any services they might render now that they are previous employees of the company. As such, I requested that Ms. Rinearson immediately provide me with copies of all documents concerning my clients' employment with your company by either Federal Express or fax. **TO DATE I HAVE NOT RECEIVED ONE DOCUMENT OTHER THAN YOUR LETTER OF JANUARY 27, 1999.** I also informed Ms. Rinearson that my clients had been given very limited documents for the review of this matter. They had received documents totaling 32 pages but did not receive a copy of any of the drawing figures which are referenced in the document itself. They understood that changes and/or modifications had been made to the subject document but have not received a summary or identification of the basis upon which those changes were made. In essence my clients have been given very limited information from a source which was not American Express without a clear explanation as to what was to be done. (My clients did receive a telephone call from Ms. Rinearson on January 22, 1999 where in she left a voice mail stating that she would like wanted the applications signed if my clients were willing to do so.)

Although I spoke with Ms. Rinearson on Tuesday afternoon as a follow up to my voice mail message left on Monday afternoon, the only written contact I have received is your threatening letter of January 27, 1999 faxed to me at 5:00. Because I was out of the office at that time I did not see the letter until I returned to the office this morning. Although your letter speaks for itself, it is my interpretation that your letter is not only full of threats that the vast resources of American Express will be used against my clients if they are not willing to simply act as American Express might demand but, additionally, you have in essence required that they are to sign the application although they have not received the entire document. Your letter requires them to cooperate fully with American Express although you have not provided specific legal authority, contracts and documents to confirm said requirement. They are not allowed to make modifications which they might believe are required or necessary to the subject application because of what you term to be extensive work with Mr. Blandina. You place on my clients some type of emergency as a result of what has evidently been either a deliberate or negligent delay by you and/or your company. You provide no explanation why this very urgent and apparently important matter was not addressed by American Express until a simple, non-assuming voice mail was left for my clients on January 22, 1999 and your threatening letter was sent on January 27th 1999. I am certain you realize that both my clients were required to seek other employment once their relationship ended with American Express. Waiting until 5:00 p.m. 3on Wednesday afternoon to fax your demand letter notwithstanding my communication with Ms. Rinearson on Tuesday afternoon is unexplained. You somehow believe that my clients should place their current jobs and lives on hold, budget 4 hours for American Express over the 48 hours in which you have given them to act and sign an incomplete application which American Express has not even bothered to send directly to my clients. These actions are to be taken by my clients notwithstanding the fact that American Express and your firm have been working on this matter since June of 1998 and have been aware as early as September of 1998

Howard I. Sobelman

January 28, 1999

Page 4

that my clients did not believe that your "application" identified anything that they might have invented. You were well aware in June of 1998 of the situation that existed. Your initial documents identified three inventors. Your decision to work with only one inventor, to either deliberately or negligently delay any contact with the other inventors and to then to place them under some type of rush is unacceptable and I do not believe it can be sustained by any legal authority which you might be able to find. Your further demand that these people must sign an incomplete application without modifications simply because American Express has made such demand and has threatened (with all its vast resources) litigation against them, cannot be supported by any legal authority. However, once again I await whatever legal authority you can provide for me concerning this matter. I also await from you and American Express all the information which I requested on Tuesday of this week. Only after I have received this information can we make an informed decision with respect to your actions, threats and demands. Without this information you leave us with no opportunity to make an informed decision. By clients believe that they must act in accordance with the law. You have made vague reference to the law but you have not provided us with any specifics. It is your office and American Express which has caused the emergency in this matter, and we believe it is you office and American Express that has the duty and responsibility to provide us with the specific legal authority which would permit you to act in the manner. We therefore await this information so that we might be able to act on it as soon as possible.

In the mean time, please be assured that Ms. Belczynski and Mr. Berry not only intend to comply with all legal duties and responsibilities which they have but also intend to enforce all legal rights which they have. I understand that you have offered them 4 hours of some type of vague compensation for the emergency work which you demand. We have no idea how much you are actually offering to either Ms. Belczynski or Mr. Berry. We also are unaware whether your offer is fair in light of the money which has been lost by Mr. Berry and Ms. Belczynski due to American Express' actions and if it is fair with regard to the actual value of the patent. We also, absent the information which I have request from you and Ms. Rinearson, are unable to determine to what extent Ms. Belczynski and Mr. Berry would be entitled to any part of the value of the patent at this time.

In closing, I also request that in addition to the above referenced information that you provide for us all records and complete and full disclosure of any value, compensation, deals, agreements, promises or other representations you have made to Mr. Blandina to obtain his cooperation in this matter. I also request copies of all documents, records, papers, files, and disclosure of all information concerning all actions taken between American Express and Mr. Blandina with respect to this patent which would clarify for us the "extensive work" which American Express has carried out with Michael Blandina in order to assure that the patent application is accurate.

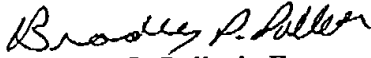
Obviously, your immediate attention to this matter is required and we await your

Howard I. Sobelman  
January 28, 1999  
Page 5

immediate response.

Thank you for your attention to this matter.

Very truly yours,

  
Bradley P. Pollock, Esq.  
BELL & POLLOCK, P.C.

BPP/eja  
cc: Bob Berry  
Mari Belczynski